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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,421	11/12/2003	Wade Carter	8130 (FSP0473)	6799
88095 ARRIS 3871 Lakefield Drive Suwanee, GA 30024	7590 12/02/2009			
EXAMINER				
TRAN, NGHI V				
ART UNIT		PAPER NUMBER		
2451				
NOTIFICATION DATE		DELIVERY MODE		
12/02/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mirho@fspllc.com

Office Action Summary

Application No.

10/706,421

Applicant(s)

CARTER ET AL.

Examiner

NGHI V. TRAN

Art Unit

2451

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 26-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This office action is in response to the amendment filed on July 13, 2009. Claims 1 and 13 have been amended. Claims 19-25 have been canceled. Claims 26-27 have been added. Therefore, claims 1-18 and 26-27 are presented for further examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 13-18 are rejected under 35 U.S.C. 101 because of the following reasons:

4. Claim 13 would reasonably be interpreted by one of ordinary skill as a system of software per se (software means only and not embedded in a computer readable storage medium), failing to fall within a statutory category of invention. As such, the system of software means alone is not a machine, and it is clearly not a process, manufacture nor composition of matter. Although the claim recites "a system for configuring a first network device in a communication network, comprising: means for setting ...; means for saving ...; means for loading ...; and means for setting .. in the configuration file" the claim actually lacks the necessary physical articles / objects / elements / components / structure / hardware such as memory and a processor to constitute a machine or manufacture within the meaning of 35 USC 101. They are

clearly not a series of steps or acts to be process nor are they a combination of chemical compounds to be a composition of mater.

5. Claims 14-18 are also rejected under 35 U.S.C. 101 because claims 14-18 are directly depend on its independent claim 13.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-18 and 26-27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

8. In claims 1 and 13, the applicants wrote "each values representing the at least one subset without including the plurality of individual configuration parameters contained in each selected subset" (emphasized added). The examiner cannot find any support for this limitation. The examiner considers the "without" as a negative limitation. According to MPEP217.05 (i), "any negative limitation or exclusionary proviso must have basis in the original disclosure". Since the applicants does not positively describe that each values representing the at least one subset without including the plurality of

individual configuration parameters contained in each selected subset, the examiner consider the limitation "without including the plurality of individual configuration parameters contained in each selected subset" as a new matter.

9. Claims 2-12, 14-18, and 26-27 are also rejected under 35 U.S.C. 112, first paragraph, because claims 2-12, 14-18, and 26-27 are directly depend on its independent claims 1 and 13.

Response to Arguments

10. Applicant's arguments with respect to claims 1-18 and 26-27 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's arguments filed on July 13, 2009, have been fully considered but they are not persuasive because claims 13-18 have been rejected under 35 USC 101 as a system of software per se (software means only and not embedded in a computer readable storage medium), failing to fall within a statutory category of invention. As such, the system of software means alone is not a machine, and it is clearly not a process, manufacture nor composition of matter. Although the claim recites "a system for configuring a first network device in a communication network, comprising: means for setting ...; means for saving ...; means for loading ...; and means for setting .. in the configuration file" the claim actually lacks the necessary physical articles / objects / elements / components / structure / hardware such as memory and a processor to

constitute a machine or manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be process nor are they a combination of chemical compounds to be a composition of mater. However, the rejection is not related Bilski rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi V. Tran whose telephone number is (571) 272-4067. The examiner can normally be reached on Monday-Thursday (9:30-8:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John Follansbee/
SPE 2451